

Remarks:

Claims 1-14 are pending in the application. Claims 1-14 are rejected. In view of the following remarks, applicant requests reconsideration of the rejected claims under 37 C.F.R. § 1.111.

Rejections under 35 U.S.C. § 103

Claims 1-14 are rejected under 35 U.S.C. § 103 as being obvious over Sevcik et al. (U.S. Patent No. 6,330,542) or Kara (U.S. Patent No. 5,983,209) alone, or in the alternative, in view of Darlington (U.S. Patent No. 5,102,200). Sevcik et al. discloses an automated Internet quoting and procurement system that provides a graphical interface between buyers of commercial printing services and the providers of those services, as shown in the figure below.

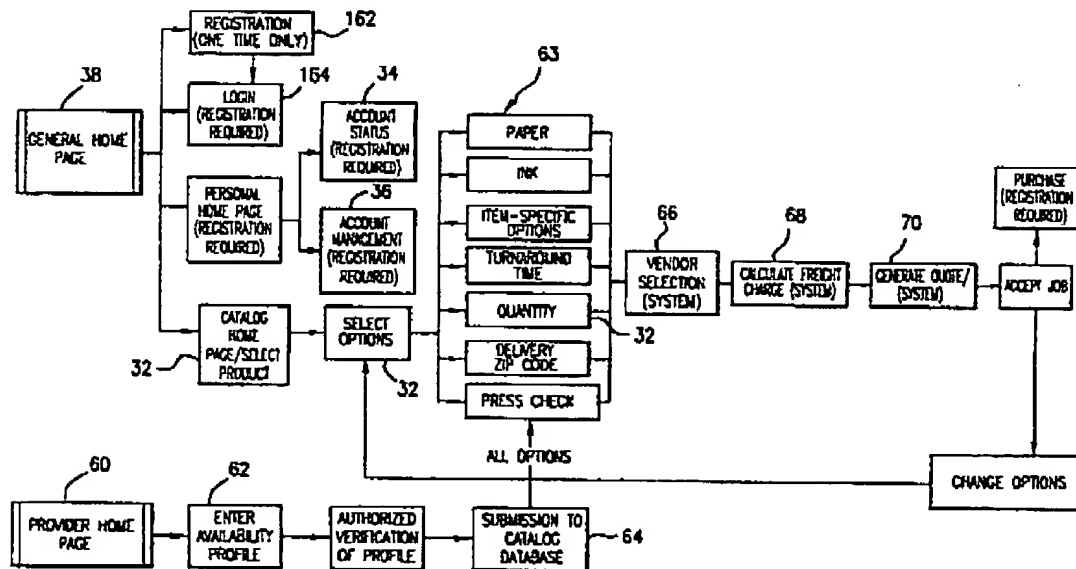


FIG. 1A

The system allows the print buyer to select among various job options at 63 to specify the desired print product. The job options include quantity, turnaround time, press check, delivery zip code and shipping method. Based on those selected options, the system selects the appropriate vendors at 66, computes the weight of the order based on quantity and paper weight, computes the freight cost at 68, and displays the most competitive pricing and freight cost at 70 (col. 9, lns. 24-50).

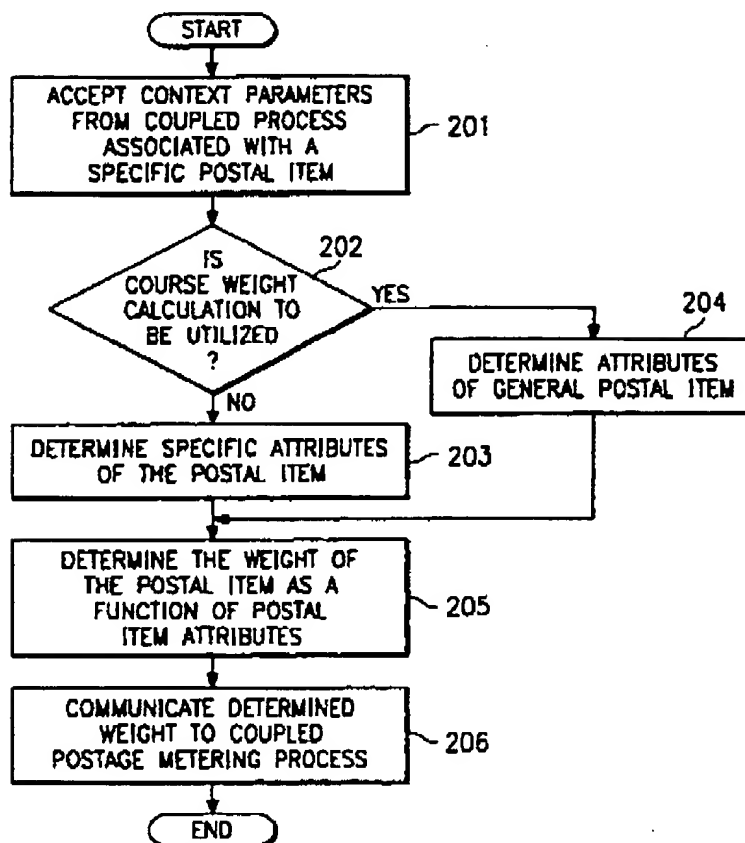
Sevcik et al. does not disclose, teach or suggest a method or system that includes providing an electronic print job having predefined electronic print job attributes that identify weight-determining factors including at least one of printer technology, ink/toner coverage and ink/toner weight, as recited in claim 1. The Examiner, in fact, acknowledges that Sevcik et al. fails to "explicitly [teach] that the weight-determined factors include at least one of printer technology, ink/toner coverage and ink/toner weight." The Examiner further indicates that this failure likely is an assumption that the weighting factor due to ink/toner printed on the surface of the sheet is very low as compared to the weight of the sheet and that the precise weight is not critical. The Examiner thus appears to argue that there is no motivation to modify Sevcik et al. to read on applicant's claims. Nevertheless, the Examiner asserts that it would have been obvious to include ink/toner (or printed material) weight on coverage as part of the weight-determining factor. Applicant respectfully disagrees.

As acknowledged by the Examiner, Sevcik et al. calculates weight of an order based only on the quantity and paper weight (column 9, lines 44-45). There is no suggestion to expand the indicated weight-determining criteria, and no motivation to do so (according to the Examiner's own interpretation of Sevcik et al.).

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Kara discloses a system and method for determining the weight of a postal item, as shown in the figure below.

FIG. 2



As indicated, the operator chooses between a course (estimated) weight based on attributes of a general postal item at 204 or a precise weight based on specific attributes of the postal item at 203 (col. 6, lns. 12-16). The attributes available for consideration are paper size, print mode, paper stock weight, associated envelope

and envelope weight. Specific attributes are stored in the system in the form of a data array similar to the table below (see column 6, lines 35-50):

<u>Context Specific Attribute Information</u>					
Process	Paper Size	Print Mode	Paper Stock Weight	Associated Envelope	Envelope Weight
Word Processor	8.5 x 11	Draft	15#	#10	.05
Word Processor	8.5 x 11	Corre- spondence	20#	#10	.05
Word Processor	5 x 7	Corre- spondence	25#	N/A	N/A
Spread Sheet	8.5 x 11	N/A	15#	10 x 13	.50
Spread Sheet	11 x 14	N/A	15#	12 x 15	.60

At 205 and 206, the system determines the weight of the postal item based on the postal item attributes, and then communicates the weight for postage metering.

Kara does not disclose, teach or suggest a method or system that includes providing an electronic print job having predefined electronic print job attributes that identify weight-determining factors including at least one of printer technology, ink/toner coverage and ink/toner weight, as recited in claim 1. In fact, the Examiner specifically recognizes that Kara fails to explicitly teach that the weight-determining factors include at least one of printer technology, ink/toner coverage and ink/toner weight, and reasons that such weighting factors are not considered "because it's reasonable to assume that the weighting factor due to ink/toner printed on the surface of the sheet is very low as compared to the weight of the sheet and precise weight figure is not critical". The Examiner thus appears to argue that there is no motivation to modify Kara.

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Darlington discloses a method for de-inking waste paper using alkoxy capped polyethylene oxide and a polymeric material. Such a reference cannot be combined with either Sevcik et al. or Kara because Darlington is nonanalogous art and therefore is improper to combine with Sevcik et al. or Kara.

In the case of *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992), the Federal Circuit provided the test to determine whether a reference in the prior art is "analogous" or not:

Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

Darlington is not from the same field of endeavor and is not reasonably pertinent to the particular problem at hand. First, Darlington's field of endeavor is the recycling of secondary fiber (col. 1, Ins. 20-35). In contrast, applicant's invention relates to calculating postage associated with mailing a printed document. Second, Darlington is concerned with providing a method of de-inking secondary fiber printed by reprographic printing processes (col. 2, Ins. 3-7), while applicant's invention is concerned with estimating postage prior to printing hardcopies of a print job. Thus, Darlington is not from the same field of endeavor and is not reasonably pertinent to the particular problem at hand. Therefore, Darlington is nonanalogous art.

Additionally, there is no suggestion, motivation or teaching to combine Darlington with Sevcik et al. or Kara. As discussed above, Darlington discloses a method of de-inking secondary fiber printed by reprographic printing process. In contrast, Sevcik et al. discloses an automated internet quoting and procurement system for commercial printing, and Kara discloses a system or method for determining postal item weight. A person skilled in the art and confronted with problems inherent in Sevcik et al. or Kara would not consult the teachings of Darlington, or vice-versa.

Moreover, even the improper combination of Darlington with either Sevcik et al. or Kara does not disclose, teach or suggest a method or system that includes providing an electronic print job having predefined electronic print job attributes that identify weight-determining factors including at least one of printer technology, ink/toner coverage and ink/toner weight, as recited in claim 1.

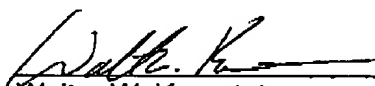
For at least the foregoing reasons, the rejection of claim 1 under 35 U.S.C. § 103 should be withdrawn. Claims 2-10 depend from claim 1, and thus are allowable for at least the same reasons as claim 1.

Like claim 1, independent claim 11 recites providing an electronic print job having predefined electronic print job attributes that identify weight-determining factors including at least one of printer technology, ink/toner coverage and ink/toner weight. Claim 11 thus is allowable for at least the same reasons as claim 1. Claims 12-14 depend from claim 11 and thus are allowable for at least the same reasons as claim 11.

Applicant believes that this application is now in condition for allowance, in view of the above remarks. Accordingly, applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to Examiner T. Nguyen, Group Art Unit 3629, Assistant Commissioner for Patents, at facsimile number (703) 305-7687 on February 16, 2005.



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